

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of : COHEN-SOLAL, Eric
Serial No. : 09/738,650
Filed : 12/15/2000
Atty. Docket : US000395
Group Art Unit : 2622
Examiner : Brian P. Yenke
Conf. No. : 1565

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Alexandria, VA 22313

APPEAL BRIEF

Sir:

Enclosed is an Appeal Brief in the above-identified patent application. Please note that an Appeal Brief was previously filed on September 19, 2005, and the Board did not render a decision on the merits of that brief. Therefore, it is believed that no fee is currently due. If, however, there are additional fees associated with this application, please charge to Deposit Account No. 14-1270.

Respectfully submitted,

By /YURI KATESHOV/
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914-723-6802

APPEAL BRIEF

I. REAL PARTY IN INTEREST

The real party in interest is Koninklijke Philips Electronics N.V. corporation, the assignee of record.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any pending appeals, judicial proceedings, or interferences which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 and 3 - 11 are finally rejected.

IV. STATUS OF AMENDMENTS

An after-final amendment under 37 CFR 1.116 was not filed in response to the Final Office Action. All amendments prior to the Final Office Action were entered into the record.

V. SUMMARY OF CLAIMED SUBJECT MATTER

One embodiment of the present invention, as recited in claim 1, is directed to a video display device, including a display (Figure 1, 110; Specification, page 5, line 17 - page 6, line 7) that displays a primary image (Figure 2A, 210B; Specification, page 7, line 23 - page 8, line 11) overlaid with a PIP (picture in picture, Figure 2A, 210A; Specification, page 7, line 19 - page 8, line 21), and a processor (Figure 1, 125) coupled to the display for receiving video streams for the primary image and for the PIP. The processor changes a PIP display characteristic, such as PIP position, size, transparency (Specification, page 11, lines 14-19), based on a characteristic of the primary image, such as a continuous color or a continuous texture of the primary image (Specification, page 10, lines 8-19; Figure 3).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether claims 1, 3 - 8 and 10 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over alleged Applicant's Admitted Prior Art (hereinafter "Applicant's specification") in view of U.S. Patent 6,396,54 (hereinafter "Shin").

2) Whether claim 9 is properly rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's specification in view of Shin and further in view of U.S. Patent Application Publication No. 2002/0069411 (hereinafter "Rainville").

VII. ARGUMENT

1) Claims 1, 3 - 8 and 10 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's specification in view of Shin.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if any one of the above-identified criteria is not met, then the cited reference(s) fails to render obvious the

claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

With respect to the instant invention, it is respectfully submitted that none of the criteria is met, as discussed below.

First, Applicant's invention is directed to a picture-in-picture (PIP) display that responds to characteristics of underlying video content (see page 1, lines 9-11 of the instant specification.) Shin is directed to a deinterlacing apparatus of digital image data by obtaining motion information and executing interpolations according to the motion information (emphasis added. See col. 1, lines 5-10 of the patent.) It is not clear as to how Applicant's PIP fits in Shin's deinterlacing apparatus of digital image data. Why would a skilled artisan, equipped with the knowledge of the Shin patent, look to a PIP? Why would a skilled artisan refer to deinterlacing of digital image data to be of relevance in re-positioning PIP in response to a determination of important and unimportant portions of primary display image? What is the connection between Shin's deinterlacing of digital image data and Applicant's re-positioning PIP in response to a determination of important and unimportant portions of primary display image? It is respectfully submitted that none exists. Only by impermissibly reconstructing Applicant's invention using it as the blueprint, the reasoning in the Office Action can be justified. Namely,

contrary to the assertions in the Office Action, there is no motivation or suggestion to augment Applicant's specification with the teaching of Shin because the two inventions are incompatible with each other.

Second, even if Applicant's specification were supplemented by Shin, the resulting combination still would not teach or suggest all elements of the claimed invention, as recited in claim 1. Namely, it appears that according to the Office Action, Shin's disclosure is used for motion detection by determining whether the color is continuous or discontinuous (see page 3 of the Office Action). However, it is respectfully submitted that this disclosure is irrelevant to Applicant's claim 1. Namely, Applicant's PIP is re-positioned, for example, in response to a determination of important and unimportant portions of primary display image ("the characteristic being at least one of a continuous color portion and a continuous texture portion" as recited in claim 1). The detection of motion in the primary display image is of no relevance to Applicant's invention. Hence, the Office Action offers irrelevant portions of Shin with respect to Applicant's claim 1 to cure the alleged deficiencies in Applicant's specification. It is respectfully submitted that Shin's motion detection/information in a primary display image fails to supplement Applicant's specification to result in Applicant's invention, as recited in claim 1.

Clearly, there is no correspondence or analogy between Shin's elements and Applicant's feature of "a processor ... configured ... to change a PIP display characteristic in response to at least one characteristic present in the primary image, wherein the PIP display characteristic is at least one of a position of the PIP on the display, a display size of the PIP, and a transparency of the PIP; said processor being configured to determine that the at least one characteristic is present in the primary image, the characteristic being at least one of a continuous color portion and a continuous texture portion," as recited in claim 1.

Furthermore, mischaracterization of Applicant's specification as the so-called Applicant's Admitted Prior Art according to the Office Action is incorrect from a legal standpoint. Nowhere does Applicant state that his statement "the PIP may be automatically repositioned to a portion of the primary display in response to detected motion between one frame of the video image and the next frame" refers to a prior art system. It is respectfully submitted that the description in the background of the invention is not prior art unless Applicant explicitly admits so. It appears that the Examiner has imputed the prior art status to Applicant's entire background of the invention section. It is impermissible under case law.

At least for the above reasons, Applicant submits that the rejection of claim 1 can't be maintained: the reasoning in the Office Action is not supported by the factual record and legal precedents. Applicant respectfully requests the Board to reverse the rejection and allow the claim.

Claims 3 - 8 and 10 depend from independent claim 1 and thus incorporate novel and non-obvious features thereof, in addition to further limitations. Therefore, dependent claims 3 - 8 and 10 are patentably distinguishable over the prior art of record for at least the same reasons as independent claim 1. Appellant, therefore, respectfully submits that the final rejection of claims 3 - 8 and 10 lacks factual and legal basis and should be reversed. Claims 3 - 8 and 10 should be passed to issue.

2) Claim 9 is not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's specification in view of Shin and further in view of Rainville.

With respect to claim 9, which depends from claim 1, Appellant essentially repeats the above arguments to submit that Rainville is not relied upon in the Final Office Action to cure the deficiencies in Shin. Therefore, Appellant's claim 9 is not rendered obvious by the prior art of record. Appellant

respectfully requests the Board to reverse the rejection and pass claim 9 to issue.

VIII. CONCLUSION

In light of the above, Appellant respectfully submits that the rejections of claims 1 and 3 - 11 are in error. The prior art references relied upon in the Final Office Action do not anticipate or render obvious Appellant's claims. Thus, Appellant respectfully submits that the rejections are in error, legally and factually, and must be reversed.

Respectfully submitted,

By /YURI KATESHOV/
Yuri Kateshov, Reg. 34,466
914-723-6802

IX. CLAIMS APPENDIX

1. A video display device comprising:

a display configured to display a primary image and a picture-in-picture

image (PIP) overlaying the primary image; and

a processor operatively coupled to the display and configured to receive a first video data stream for the primary image, to receive a second video data stream for the PIP, and to change a PIP display characteristic in response to at least one characteristic present in the primary image,

wherein the PIP display characteristic is at least one of a position of the

PIP on the display, a display size of the PIP, and a transparency of the PIP;

said processor being configured to determine that the at least one characteristic is present in the primary image, the characteristic being at least one of a continuous color portion and a continuous texture portion.

2. (Cancelled)

3. The video display device of Claim 1, wherein said processor is configured to

position the PIP on at least one of the continuous color portion and the continuous texture portion after determination of the presence of the characteristic present in the primary image.

4. The video display device of Claim 1, wherein said processor is configured to position the PIP so as to minimize overlaying of the PIP with respect to a person image on the at least one frame after determination of the presence of the characteristic present in the primary image.

5. The video display device of Claim 1, wherein processor is configured to analyze at least one frame of the first video data stream and determine whether there is a person image present in the at least one frame and at least one of a continuous color portion and a continuous texture portion as the characteristic present in the primary image.

6. The video display device of Claim 1, wherein processor is configured to analyze at least one frame of the first video data stream and determine a behavior present on the at least one frame as the characteristic present in the primary image.

7. The video display device of Claim 1, wherein the PIP display characteristic is a position of the PIP, and wherein the processor is configured to reposition the PIP to minimize overlaying a portion of the primary image when the characteristic is present in the primary image.

8. The video display device of Claim 1, wherein the PIP display characteristic is a size of the PIP, and wherein the processor is configured to resize the PIP to minimize overlaying a portion of the primary image when the characteristic is present in the primary image.

9. The video display device of Claim 1, wherein the PIP display characteristic is a transparency of the PIP, and wherein the processor is configured to render the PIP transparent to transparently overlay a portion of the primary image when the characteristic is present in the primary image.

10. The video display device of Claim 1, wherein the PIP display characteristic is a size and a position of the PIP, and wherein the processor is configured to determine the size and the position of the PIP to minimize overlaying a portion of the

primary image when the characteristic is present in the primary image.

11. The video display device of Claim 1, wherein the video display device is a television.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.